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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Brent R. Stockwell et al.	Confirmation No.:	6924
Serial No.:	09/611,835	Art Unit:	1639
Filed:	July 7, 2000	Examiner:	My-Chau T. Tran
Customer No.:	21559		
Title:	METHODS FOR IDENTIFYING COMBINATIONS OF ENTITIES AS THERAPEUTICS		

Mail Stop Appeal Brief – Patents
Commissioner for Patents
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Alexandria, VA 22313-1450

APPELLANT'S REPLY BRIEF
SUBMITTED PURSUANT TO 37 C.F.R. § 41.41

In response to the Examiner's Answer mailed on June 15, 2006 in connection with the above-captioned case, appellants submit the following Reply Brief.

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Status of Claims

All of the pending claims, claims 89-156, have been finally rejected under 35

U.S.C. § 103(a) over a single reference, Stylli et al. (U.S. Patent No. 5,985,214; "Stylli").

The rejection of all claims is appealed.

Grounds of Rejection to be Reviewed on Appeal

All of the claims were rejected for obviousness over the Stylli reference.

Argument

I. Rejection of Claims 89-108; 110; 112-129; 131; 133-145; 147; 149; 150; and
152

The Examiner asserts (page 5) that the only reference at issue, Stylli, “does suggest screening combinations of compounds.” Appellants’ strong disagreement with the Examiner’s assertion is of record in the Appeal Brief filed on March 13, 2006, and need not be recapitulated in detail. In the present paper, appellants simply wish to reiterate that the Examiner has inexplicably relied on a single sentence in Stylli: “In practicing the methods of the invention, the products or compositions can be used alone or in combination with one another, or in combination with other therapeutic or diagnostic agents.” As appellants have consistently argued throughout the prosecution of the present case, neither the above-quoted sentence, nor any other sentence of Stylli, renders Stylli relevant in any way to the patentability of the claimed subject matter.

II. Rejection of Claims 109; 111; 130; 132; 146; 151; and 153

The Examiner asserts (page 6) that Stylli “would suggest screening combinations of compounds because the phrase ‘in combination with other therapeutic or diagnostic agents’ would suggest that suggest [sic] screening combinations of compounds wherein at least [sic] of the compounds is an ‘FDA-approved drug.’” Stylli in fact teaches away from screening FDA-approved drugs, focusing instead on the discovery of novel compounds

and biological activities. For example, Stylli states (column 1, lines 6-11, emphasis added):

The present invention generally relates to automated and integrated systems and methods for rapidly identifying chemicals with biological activity in liquid samples, particularly automated screening of low volume samples for **new** medicines, agrochemicals, or cosmetics.

Stylli further states (column 42, lines 26-35, emphasis added):

The invention includes novel chemicals identified as having activity by the operation of methods, systems or components described herein. **Such novel chemicals do not include chemicals already publicly known in the art as of the filing date of this application.** Typically, a chemical would be identified as having activity from using the invention and then its structure revealed from a proprietary database of chemical structures or determined using analytical techniques.

FDA-approved drugs are necessarily publicly known in the art, and the use of such drugs would defeat the main purpose of the invention disclosed in Stylli, which is to discover new drugs. Therefore, nothing in Stylli can reasonably be taken to either teach or suggest the screening of FDA-approved drugs.

III. Rejection of Claims 154-156

The Examiner asserts (page 8) that Stylli “does suggest screening the compounds individually for activity and screening the combination of compounds for activity.” The Examiner cites several passages of Stylli to support this contention. Nowhere in Stylli, including in the passages cited by the Examiner, is the feature of testing compounds individually prior to testing combinations taught or suggested. Furthermore, there is no

suggestion or motivation to combine the cited passages of Stylli, which are several pages apart, nor would the combination of these passages render the presently-claimed subject matter obvious.

Appellants recognize, and completely support, the public policy of denying patents on obvious inventions. However, in the present case, the reference of record, Stylli, does not have anything to do with the claimed invention. Appellants again point out this obvious fact and request prompt reversal of this clear error.

Conclusion

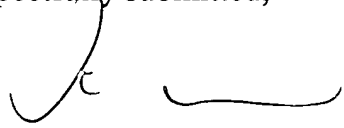
Appellants respectfully request that the rejection of claims 89-156 be reversed.

If there are any charges or any credits, please apply them to Deposit Account No.

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Respectfully submitted,

Date: Aug. 14, 2008



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